

### **REMARKS**

Claims 1-17 remain pending in this application. Claims 1, 9, and 14 are independent. Claims 1 and 6 have been amended. No claims have been added or canceled by this Amendment. No new matter is involved with any amendment.

### **Objection to the Specification**

Withdrawal of the objection to the Specification is requested. The Specification has been amended in a manner that is believed to overcome the Examiner's stated bases for objection. No new matter is involved with any Specification amendment.

To ensure a clear record, Applicants note that the Examiner objected to the Specification as not providing antecedent basis in the claims for the acronyms "GPRS, the LR, the CTR, the XER and the CR", purportedly the "claimed subject matter".

However, these terms, although not spelled out in the Specification before amendment, are submitted as being well-known acronyms at the time of the invention. In addition, none of these acronyms were present in any claim, original or amended.

### **Objection to the Drawings**

Withdrawal of the objection to the Drawings is requested. As discussed above, the Drawings and Specification have both been amended in a manner that is believed to overcome the Examiner's stated bases for objection. No new matter is involved with any Drawing amendment.

### **Enablement Rejection Under §112**

Withdrawal of the rejection of claim 6 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement is requested.

As clarified in a telephone exchange between the undersigned and Examiner Hein on March 2, 2006, the enablement rejection against “claim 6” was intended instead to be a rejection of independent “claim 9”.

With regard to enablement of computer-implemented devices or methods, the Federal Circuit has stated the following:

When the challenged subject matter is a computer program that implements a claimed device or method, enablement is determined from the viewpoint of a skilled programmer using the knowledge and skill with which such a person is charged. The amount of disclosure that will enable practice of an invention that utilizes a computer program may vary according to the nature of the invention, the role of the program in carrying it out, and the complexity of the contemplated programming, all from the viewpoint of the skilled programmer.<sup>1</sup>

It appears that the Examiner may be confusing Applicants’ usage of the phrase “search engine” with the current-day usage of that phrase to denote software and computer server hardware that operate through a web browser to search the internet, e.g., “Google” or “AltaVista” types of programs.

Applicants submit that the term “search engine” is broader than the common layman usage now commonly associated with internet searching, and would be adequately and well-understood by a person of ordinary skill in the art at the time the present application was filed.

Simply stated, a search engine is software that searches for data based on some criteria. Confirming this definition, and consistent with the statements above, the following definitions of “search engine” is offered for consideration by the Examiner:

Software that searches for data based on some criteria. ***Although search engines have been around for decades, they have been brought to the forefront since the World Wide Web exploded onto the scene.*** Every Web search site uses a search engine that it has either developed itself or has purchased from a third party.

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<sup>1</sup> *Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1329 (Fed. Cir. 1990).

Search engines can differ dramatically in the way they find and index the material on the Web, and the way they search the indexes from the user's query.<sup>2</sup>

An additional definition of “search engine” provided by Wikopedia, the online encyclopedia is:

. . . a program designed to help find information stored on a computer system such as the World Wide Web, inside a corporate or proprietary network or a personal computer. The search engine allows one to ask for content meeting specific criteria (typically those containing a given word or phrase) and retrieves a list of references that match those criteria. Search engines use regularly updated indexes to operate quickly and efficiently. Without further qualification, search engine usually refers to a Web search engine, which searches for information on the public Web. Other kinds of search engine are enterprise search engines, which search on intranets, personal search engines, which search individual personal computers, and mobile search engines. However, while different selection and relevance criteria may apply in different environments, the user will probably perceive little difference between operations in these.<sup>3</sup>

Further, under 35 U.S.C. §112, a specification need not teach that which is obvious to those in the art.<sup>4</sup> “A patent need not teach, and preferable omits, what is well know in the art.”<sup>5</sup> Finally, “[t]he disclosure of an application embraces not only what is expressly set forth in words and drawings, but what would be understood by persons skilled in the art. Those features that are well known are as if they were written out in the patent.”<sup>6</sup>

Therefore, Applicants submit that a person of ordinary skill in the art would have well-understood how to make and use the invention claimed in independent claim 9 without undue experimentation, given Applicants’ disclosure and the general knowledge that a person of ordinary skill in the art would have had regarding the phrase “search engine”, in the context of multi-thread computing devices, database search techniques, and related operating system principles.

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<sup>2</sup> Computer Desktop Encyclopedia, 9th ed., Alan Freedman, Editor, Osborne/McGraw Hill, Berkeley, California, 2001, p. 874 (“search engine”) (*emphasis added*).

<sup>3</sup> See [http://en.wikipedia.org/wiki/Search\\_engine](http://en.wikipedia.org/wiki/Search_engine)

<sup>4</sup> *In re Sureau, Kremer, and Dupre*, 153 USPQ 66, 70 (C.C.P.A. 1967).

<sup>5</sup> *Spectra-Physics Inc. v. Coherent Inc.*, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987).

<sup>6</sup> *Ex parte Wolters and Kuypers*, 214 USPQ 735 (PTO Bd. App. 1979).

Accordingly, withdrawal of the enablement rejection and allowance of claim 9 are respectfully requested. In addition, allowance of dependent claims 10-13 is also requested.

### **Indefiniteness Rejection Under §112¶2**

Withdrawal of the rejection of claims 1 and 6 under 35 U.S.C. §112, second paragraph, as being indefinite, is requested.

These claims have been amended in a manner that is believed to overcome the stated bases for indefiniteness. No new matter is involved with any claim amendment.

Consideration and allowance of claims 1-8 are therefore respectfully requested.

### **Allowable Subject Matter**

Applicants note with appreciation that claims 14-17 have been indicated as being allowed, and that claims 2-5, 7-8, and 10-13 are drawn to allowable subject matter, and would be allowed if rewritten in independent form.

In light of the clarifying amendments to claims 1 and 6, claims 1-8 are submitted as being allowable.

In light of the remarks made in connection with the enablement rejection of claim 9, claims 9-13 are also submitted as being allowable.

### **Conclusion**

In view of the above amendment and remarks, Applicants believe that each of pending claims 1-17 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

Although no fees are believed to be due with this response, for any fees that are due, including fees for extensions of time, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application to IBM Deposit Account No. 50-0563, under IBM Order No. RPS920030065US1 from which the undersigned is authorized to draw.

Respectfully submitted,

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Attachments: Replacement Drawing Sheet (FIGS. 1-2)